



Remarks/Arguments

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Claims 6-12 are pending in this application and claims 6-10 and 12 are rejected over various grounds. Claim 11 has been withdrawn from consideration. Without acquiescing to the Examiner's position in the current rejections, and without prejudice to further prosecution of the subject-matter in one or more continuation or divisional applications, Claims 6-12 have been canceled, and new claims 20-26 have been added.

Priority

The new claims 20-26 are directed to subject matter disclosed in the specification as originally filed. Support for the new claims can be found in the specification on following pages:

Claim Number	Phrase	Support
20	pathological conditions	at least at page 5, lines 26-32, and page 91, lines 6-20
21	malignancies	at least at page 5, lines 17-19, and page 91, line 11
22	overexpress	at least at page 5, lines 17-19, and page 10, lines 20-25
23	pancreas	at least page 91, line 9
24	aberrant sprouting in epilepsy	at least page 91, line 12
25	psychiatric disorder	at least page 91, lines 12-13
26	BDNF, NT-3 and NT-4/5	at least page 4, line 10

No new matter is introduced by way of the addition of new claims. Accordingly, the present claims are entitled to the priority date of March 18, 1994.

35 U.S.C. § 112, First Paragraph /New Matter

Claims 6-8, 10 and 12 have been rejected under 35 U.S.C. §112, first paragraph "as containing subject matter which was not described in the specification in such a way

as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

Claims 6-12 have been canceled. Therefore, the present rejection is believed to be moot. In addition, as discussed above, the currently added claims are fully supported by the specification as originally filed, and no new matter is introduced by the addition of these claims.

35 U.S.C. § 112, Second Paragraph

(1) Claims 6-8, 10 and 12 have been rejected for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner noted that Claims 6-8, 10 and 12 are indefinite for the use of the language "differential expression" in claim 6, which could be both "increase and decrease" of the expression of the TrkB.

Claims 6-12 have been canceled and new claims 20-26 have been added. As the phrase objected to is no longer present in the claims, the present rejection should be withdrawn.

(2) Claims 6-8, 10 and 12 have been rejected for being indefinite because Claim 6 allegedly missed an important step. Claims 6-12 have been canceled and new claims 20-26 have been added. Therefore, the present rejection is believed to be moot.

(3) Claims 6-8, 10 and 12 have been rejected for being indefinite for the use of the language "characterized" in claim 6. Claims 6-12 have been canceled and new claims 20-26 have been added. Since the phrase objected to is no longer present in the claims, the present rejection should be withdrawn.

35 U.S.C. § 112, First Paragraph/Scope

Claims 6-8, 10 and 12 were rejected under 35 U.S.C. 112, first paragraph because "[t]he specification ... does not reasonably provide enablement for diagnosis of any

pathological conditions or any neurodegenerative diseases, comprising detecting the presence of any forms of trkB in any tissues."

Claims 6-12 have been canceled and new claims 20-26 have been added.

Pathological conditions associated with endogenous neurotrophin production were known in the art at the earliest priority date of the present application. For example, it was known that the production of neurotrophins by human malignant gliomas cells is a general phenomenon. (See Hamel *et al.*, *J. Neurosci. Res.* 34(2):147-157 (February 1993), a copy of which is submitted with the attached Information Disclosure Statement). It was also known that seizures induced by hippocampal kindling lead to elevated levels of trkB mRNA and trkB protein. (See Merlio *et al.*, *Neuron* 10(2):151-164 (February 1993), a copy of which is submitted with the attached Information Disclosure Statement). Furthermore, studies have shown that mild brain insults, such as depression, can lead to increased levels of neurotrophin mRNAs. (See Kokaia *et al.*, *Mol. Brain-Res.* 19(4):277-286 (September 1993), a copy of which is submitted with the attached Information Disclosure Statement). Consequently, based on general knowledge in the art and the disclosure of the present application, at the earliest priority date of the present application one was able to make and use the invention defined by the currently added claims, without undue experimentation. It is well established that the fact that some experimentation may be necessary, or time consuming, does not make such experimentation "undue," as long as the techniques used are readily available, as they are in the present case.

Therefore, the newly added claims 20-26 should not be subject to a rejection on the ground of alleged lack of enablement.

35 U.S.C. § 102

Claims 6-7, 9-10, 12 were rejected under 35 U.S.C. 102(b) "as being anticipated by Connor *et al.* 1996."



Claims 6-12 have been canceled and new claims 20-26 have been added.

Therefore, the present rejection is believed to be moot.

Applicants respectfully emphasize that the present claims are entitled to the priority date of March 18, 1994. Accordingly, Conner et al. is not available as prior art under 35 U.S.C. 102(b) for the current claims.

35 U.S.C. § 103

Claims 6, 8 are rejected under 35 U.S.C. 103(a) "as being unpatentable over Conner et al. (dated 1996)."

Claims 6-12 have been canceled and new claims 20-26 have been added. Therefore, the present rejection is believed to be moot.

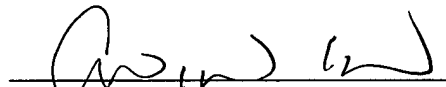
Since claims are entitled to the priority date of March 18, 1994, Conner et al. is not a prior art under 35 U.S.C. 102 and is not available under 35 U.S.C. §103(a). Therefore, a similar rejection of new claims 20-26 would be improper.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any fees, including any fees for extension of time, or credit overpayment to Deposit Account No. 08-1641.

Respectfully submitted,

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